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/Kathryn Marley/

Kathryn Marley

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Inventor:

Subir K. Ghosh et al.

Application No.: **10/619,798**

Confirmation No. **7888**

Filed: **15 July 2003**

Title: **Predictive Snooping of Cache Memory for Master-Initiated Accesses**

Group Art Unit: **2188**

Examiner: **Kevin L. Ellis**

Customer No. 22470

MAIL STOP RCE

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. §1.56

Sir:

This Information Disclosure Statement is filed to bring to the attention of the Examiner two contentions raised by the alleged infringer in a recent lawsuit involving ancestors of the subject patent application.

Alleged Prior Invention at Intel Corporation

The alleged infringer contended that the activities of a group at Intel Corporation constitutes prior art to the patents-in-suit under 35 USC 102(g)(2). Applicants vigorously denied this contention, and the lawsuit has since been settled without a decision on its merits. In order to ensure that the record before the Patent Office is complete, Applicants now bring the contention to the attention of the Examiner.

The alleged infringer contended that the alleged invention of Hayek U.S. Patent No. 5,630,094, which Applicants submitted to the Examiner in an ancestor of the present patent application, carried a date of conception that was as early as April 1994. However, Applicants submit that no complete "conception" occurred until at least the filing date of the application that led to the Hayek patent, which was January 20, 1995. Applicants have already proven, to the satisfaction of the Examiner, that they reduced their own invention to practice prior to January 1995. See the two Declarations under 37 CFR 1.131(b), both filed May 18, 1998 in ancestor U.S. patent application No. 08/851,666 (now U.S. patent No. 5,813,036).

Since Applicants' invention was reduced to practice even before the Intel group had a complete "conception," Applicants' date of invention preceded that of the Intel group.

Accordingly, the activities of the Intel group cannot constitute prior art to the present patent application under 35 USC 102(g)(2).

Alleged Prior Invention at Compaq Computer Corporation

The alleged infringer also contended that the activities of a group at Compaq Computer Corporation constitutes prior art to the patents-in-suit under 35 USC 102(g)(2). Applicants vigorously denied this contention as well, and as mentioned above, the lawsuit has since been settled without a decision on its merits. In order to ensure that the record before the Patent Office is complete, Applicants now bring this contention as well to the attention of the Examiner.

The Compaq activities pertained to a chipset (sometimes referred to herein as the "Compaq Tri-flex chipset") which the alleged infringer portrayed as having formed the basis for Compaq's U.S. patent Nos. 5,634,073 to Collins, 5,819,105 to Moriarty, and 5,938,739 to Collins (the "Compaq Patents"). These three patents have already been considered by the Examiner in the present case as 35 USC 102(e) art, and the Examiner has allowed the currently pending claims over these patents. See the Notice of Allowance mailed October 13, 2006. Applicants now bring the Compaq activities to the attention of the Examiner for consideration under 35 USC 102(g)(2).

Applicants asserted during the litigation that claims 1, 7, 8, 9, 21 and 26 of U.S. patent No. 5,710,906, the original parent of the present application, were embodied in the Compaq Tri-flex chipset as ultimately implemented. However, Applicants submit that the Compaq group's date of invention was no earlier than October 14, 1994, the earliest effective filing date claimed by any of the three Compaq Patents. Applicants further submit that the Compaq group did not even have a complete "conception" of the invention prior to that date. Applicants, on the other hand, can establish a date of invention well prior to October 14, 1994. Specifically, Applicants can establish a date of conception well prior to October 14, 1994, and diligent reduction to practice thereafter.

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It is requested that the information identified in this statement be considered by the Examiner and made of record in the above-identified application. This statement is not intended to represent that a search has been made or that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 C.F.R. 1.56.

Enclosed with this statement is a Form PTO-SB/08. The Examiner is requested to initial the form and return it to the undersigned in accordance with M.P.E.P. 609.

This statement should be considered under 37 C.F.R. 1.97(b) because it is being filed before the mailing date of the first Office Action after the filing of a Request for Continued Examination under 37 C.F.R. 1.114.

Fee Authorization. The Commissioner is hereby authorized to charge underpayment of any additional fees or credit any overpayment associated with this communication to Deposit Account No. 50-0869 (OPTI 3140-6). A copy of this authorization is enclosed.

Respectfully submitted,

HAYNES BEFFEL & WOLFELD LLP

Date: 11 January 2007

By: /Warren S. Wolfeld/
Warren S. Wolfeld, Reg. No. 31,454

HAYNES BEFFEL & WOLFELD LLP
P.O. Box 366
Half Moon Bay, CA 94019
Telephone: (650) 712-0340
Facsimile: (650) 712-0263

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Substitute for form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>		Complete if Known	
		Application Number	10/619,798
		Filing Date	15 July 2003
		First Named Inventor	Subir K. Ghosh
		Art Unit	2188
		Examiner Name	KEVIN L. ELLIS
Sheet 1	of 1	Attorney Docket Number	OPTI 3140-6

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		Alleged Prior Invention by Intel Corporation	
		Alleged Prior Invention by Compaq Corporation	

Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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